UNITED STATES PATENT AND TRADEMARK OFFICE

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09/767,842	01/24/2001	Toshiyuki Waida	1081.1104/DSG	3353

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EXAMINER
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ART UNIT	PAPER NUMBER
3693	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	09/767,842	WAIDA ET AL.
Office Action Summary	Examiner	Art Unit	
	STEFANOS KARMIS	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _05 February 2009_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,4,6,9 and 11-15_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,4,6,9 and 11-15_ is/are rejected.

7)☒ Claim(s) _9_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

1.   The following communication is in response to Applicant's amendment filed 05 February

2009.

Status of Claims

2.   Claims 1, 6 and 15 are currently amended. Claims 1, 4, 6, 9, 11-15 are currently pending

and under prosecution.

Claim Objections

3.   Claim 9 is objected to because of the following informalities: Claim 9 is listed as being

dependent on the "apparatus of claim 1." However, claim 1 is drawn to a method. Independent

claim 6 is drawn to an apparatus. The Examiner believes Applicant intended to have claim 9

dependent claim 6. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

5.   Claims 1, 4, 11, 12 and 15 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

        Independent claim 1 recites a process comprising the steps of acquiring, searching,

determining, recovering, etc. Based on Supreme Court precedent, a proper process must be tied

to another statutory class or transform underlying subject matter to a different state or thing

(*Diamond v. Diehr,* 450 U.S. 175, 184 (1981); *Parker* v. *Flook,* 437 U.S. 584, 588 n.9 (1978);

Gottschalk v. Benson, 409 U.S. *63,* 70 (1972); *Cochrane* v. *Deener,* 94 U.S. 780,787-88 (1876)).

Since neither of these requirements is met by the claim, the method is not considered a patent

eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should

positively recite the other statutory class to which it is tied, for example by identifying the

apparatus that accomplished the method steps or positively reciting the subject matter that is

being transformed, for example by identifying the material that is being changed to a different

state. Simply reciting a specific machine or a particular transformation of a specific article in an

insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Independent claim 15 is rejected based on similar reasoning to claim 1. Claims 4, 11 and

12 are rejected based on their dependency to claim 1.

Claim Rejections - 35 USC § 112

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

7.   Claims 1, 4, 6, 9, 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Regarding claim 1, the phrases "judging whether or not" and "character-recognizing...if

judged" and "determining whether or not" render the claim indefinite because these claims steps

are not positively recited and instead are conditional. For example, it is not clear what happens

when a hyphen is not judged to be part of the hyphen arrangement and whether art reading on

this limitation would thus read on the claims because the remaining limitations in the claim

would no longer be required. Further it is not clear how the form is discriminated as suggested

in the preamble of the claim. Claims 4, 6, 9, 11-15 are rejected under similar reasoning. The

Examiner suggests amending the claims to recite active steps so that patentable weight is given

to all steps in the claim.

The Examiner believes a telephone interview would be beneficial to assist the Applicant

in amending the claims into active limitations with full patentable weight. This would assist

overcoming this rejection and help to overcome the prior art. Therefore, the Examiner invites

the Applicant to schedule an interview at Applicant's convenience.

Response to Arguments

8.   Applicant's arguments with respect to claims 1, 4, 6, 9 and 11-15 have been considered

but are moot in view of the new ground(s) of rejection.

9.   Applicant argues that Krouse in view of Kolling fails to teach searching for the payee

account number in the image data at an unknown position in accordance with an account number

searching rule, and determining a type of the form based on the payee account number from a

document information table the stores account numbers correlated with types of form.

The Examiner Respectfully disagrees. Krouse teaches searching various types of

documents that contain account numbers in various different positions (column 18, lines 31-34;

and Figures 8A-8F; Examiner notes that the account number (408) is located in various

positions). Therefore, when the form is first scanned, the form is unknown and therefore the

locations of the account number is unknown. Therefore Krouse further teaches searching for the

payee account number in the image at an unknown position (column 12, lines 63 thru column 13,

line 11 and column 14, lines 17-63 and column 18, lines 31-34; Examiner notes that a user could

physically search the different invoice types to locate the account numbers in an unknown

position since the searching is not tied to a processor or computer instructions) and determining a

type of the form based on the payee account number from a document information table that

stores account numbers correlated with types of the form (column 14, line 44 thru column 15,

line 10 and column 18, lines 31-34). Therefore, Applicant's arguments are not persuasive.

10.   Applicant also argues that Krouse in view of Killing fails to teach searching for hyphens

in the image data and character recognizing the image data in areas surrounding the searched

hyphen to determine whether an account number is matched.

        The Examiner respectfully disagrees. The Examiner acknowledges that Krouse fails to

teach searching for the account number using a rule that searches for hyphens in the image and

recognizes the payee account number in areas surrounding a hyphen found in the image. Kolling

teaches an electronic statement presentment system. A template authoring workstation is used in

conjunction with authorizing tools to present billing information (column 9, lines 53-67).

Kolling teaches the use of OCR on scanned images to acquire the necessary information to

present the billing information (column 10, lines 10-34). Kolling further teaches a universal

biller file which is a database of biller information and includes a record for each biller in the

system (column 14, lines 42-49). Kolling teaches that biller information includes information

including information describing the biller company name, address, telephone and contains

information that identifies the formats for a customer biller account number that the biller

accepts from the customer (column 14, lines 50-67). The account numbers have particular

formats including hyphens which recognize the account number as being acceptable (column 14,

lines 50-67). As discussed above it is unclear what Applicant considers to be a hyphen

arrangement and therefore, given the broadest reasonable interpretation, Kolling teachings of

recognizing an account number pattern by locating a hyphen conforms to judging whether the

account number has a specified hyphen arrangement. Therefore, Applicant's arguments are not

persuasive.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

12.   Claims 1, 4, 6, 9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Krouse et al. (hereinafter Krouse) U.S. Patent 6,097,834 in further view of Kolling et al.

(hereinafter Kolling) U.S. Patent 6,385,595.

        Regarding independent claim 1, Krouse teaches a financial transaction processing system

and method, comprising: acquiring an image of the form by optically reading the form (column

12, lines 38-62); searching for the payee account number in the image at an unknown position

(column 12, lines 63 thru column 13, line 11 and column 14, lines 17-63 and column 18, lines 31-34; Examiner also notes that a user could physically search the different invoice types to locate the account numbers in an unknown position since the searching is not tied to a processor or computer instructions); determining a type of the form based on the payee account number from a document information table that stores account numbers correlated with types of the form (column 14, line 44 thru column 15, line 10 and column 18, lines 31-34); and recovering other data from locations according to the determined type of form (column 14, line 44 thru column 15, line 10).

Krouse fails to teach searching for the account number using a rule that searches for hyphens in the image and recognizes the payee account number in areas surrounding a hyphen found in the image. Kolling teaches an electronic statement presentment system. A template authoring workstation is used in conjunction with authorizing tools to present billing information (column 9, lines 53-67). Kolling teaches the use of OCR on scanned images to acquire the necessary information to present the billing information (column 10, lines 10-34). Kolling further teaches a universal biller file which is a database of biller information and includes a record for each biller in the system (column 14, lines 42-49). Kolling teaches that biller information includes information including information describing the biller company name, address, telephone and contains information that identifies the formats for a customer biller account number that the biller accepts from the customer (column 14, lines 50-67). The account numbers have particular formats including hyphens which recognize the account number as being acceptable (column 14, lines 50-67). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the character

recognition and comparing those to reference recognition characteristics teachings of Krouse to

include account numbers in a specified format because it identifies and associates the financial

document for appropriate processing and presentation based on recognized characters.

Independent claims 6 and 15 are substantially similar to claim 1 and therefore are rejected under

similar reasoning.

Claims 4 and 9, Krouse teaches recognizing a plurality of account numbers on the

payment form (column 14, lines 17-63); and merging a plurality of results, which have

recognized to determine the payee account number (column 14, lines 17-63; Examiner notes that

the plurality of recognized characters are merged together for an account number). Kolling also

teaches merging a plurality of numbers to determine a payee account number in accordance with

the proper format (column 14, line 50 thru column 15, line 15).

Regarding claims 11 and 13, Krouse teaches character recognition teachings (column 14,

line 44 thru column 15, line 10 and column 18, lines 31-34). Kolling teaches determining if an

account number including hyphens conforms to the account number scheme (column 14, line 50

thru column 15, line 15). Therefore it would be obvious to one of ordinary skill in the art to have

modify the character recognition teachings of Krouse to include searching for the hyphen with

the account conforming teachings of Kolling because it assists is processing the financial form

based on a customer/account identifier.

13.   Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krouse

et al. (hereinafter Krouse) U.S. Patent 6,097,834 in further view of Kolling et al. (hereinafter

Kolling) U.S. Patent 6,385,595 in further view of Geisel et al. U.S. Publication 2002/0073060.

Regarding claims 12 and 14, Krouse in view of Kolling teaches character recognition

when reading an account number. Krouse in view of Kolling fails to specify merging a result

from a rejected number of a plurality of character recognition results and a number of

recognition characters. Geisel teaches a computer implemented method for item processing that

provides confidence-based matching of unreadable characters during character recognition in an

attempt to determine the proper character (page 3, paragraph 0036). Therefore it would have

been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify

the teachings of Krouse in view of Kolling and include merging results from a reject number of

plurality of said character recognition and recognition characters because it allows for accurately

reading account numbers even when there could be a minor or obvious exception in the account

number.

Conclusion

14.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-

6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
25 April 2009